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22879 7590 07/08/2009 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER NGUYEN, THUY-VI THI				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/678,464

**Applicant(s)**

BRESNIKER ET AL.

**Examiner**

THUY-VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on 05/22/09, wherein:  
Claims 1-20 are currently pending;  
Claims 1-8, 17-18 have been amended;

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/22/09 has been entered.

#### ***Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 8-16** are rejected under 35 U.S.C. 101 because the claims deal with a rack equipment information system containing 4 items: 2 information repository and a coordination component and a repository management component which appear to be software components and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble "*a rack equipment information system*", however, there are no normal structures or functional elements which are

required in an apparatus claim. For instant, the independent 8 recited "*an equipment description information repository, a management plan information repository, a coordination component, a repository management component*" are appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

In additional, **Claims 17-20** are rejected under 35 U.S.C. 101 because the claims deal with a system which contains software and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble "*a computer system*", however, there are no normal structures or functional elements which are required in an apparatus claim. For instant, the independent 8 recited "*a means for controlling...; means for communicating...; means for storing...; means for processing...; a rack equipment management plan module...; a rack equipment correlation module...; an instruction saving module...*" are appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 8-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 8, first step recite the limitation "said equipment description information comprising physical bulk storage coupled with a computer" is vague and indefinite. It is not clear how the information comprising the physical bulk storage. Does it mean said equipment description information repository?

7. Claim 8, the forth step recites the limitation "said management plan information and also controls population of said equipment description information into said equipment description information" is vague and indefinite. It is not clear how management plan information controls said equipment description information into said equipment description.

8. In claim 17, claim element "means for receiving ...., means for creating ...; means for determining...." is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Therefore, applicant is required to

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so

that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. F& more information, see 37 CFR 1.75(d) aid MPEP 21si and 608.01(0).

**Note:** if the "means for" is simply software, then the system of claim 17 would be software per se and would not be non-statutory

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'KANE, JR. ET AL. (US 6,366,919).

**As for independent claim 1**, O'KANE, JR. ET AL. disclose a computer implemented rack equipment management information coordination method comprising:

a) designing or arrangement or configuration of a rack equipment management plan using a computer, the rack equipment management plan includes information data such as equipment management and usage policies and establishes an association between a rack equipment performance action and a trigger

{see col. 2, lines 33-39 discloses the *creating designs of racks using a performance characteristics of the telecom equipments*; at least figures 3, 5, 7, 12-13 and at least col. 5, lines 47-59; col. 7, lines 64-67, col. 8, lines 1-6; and lines 1-2; col. 9, lines 1-16, and lines 38-67 wherein O'KANE ET AL discloses the arrangement of a rack equipment management plan, and usage policies for example; a determination as to what the environmental factors *applicable to the site is made such as available cooling power, humidity level*, the design of rack *to determine when and if a particular design exceeds acceptable parameter values such as power, cooling, dimensions and positional requirements* (interpreted to be rack equipment plan) and col. 5, lines 47-59 discloses *the total power demanded by all of the telecom components in a particular rack does not exceed a certain portion*, such as 80% of the power supply in the rack (interpreted to be usage policies) ; and col. 4, lines 1-9 discloses the telecom equipment power requirements, heating loads or power consumed telecom ports, performance capabilities, form factors needed to mount the telecom equipment in racks;

and wherein said rack equipment management plan is a plan for managing rack equipment operating characteristic while said rack equipment is in operation;

{see figures 3-5, 7, 10-11}

b) automatically detecting/monitoring and retrieving using computer, rack equipment description information from at least one component comprising said rack equipment, wherein said rack equipment descriptive information comprises an identification of equipment type of said at least one component;

{see figures 1, 5, 7, 11-13 col. 4, lines 4-9; col. 7, lines 64-67; col. 8, lines 1-35 wherein O'KANE, JR. ET AL discloses automatically *monitored* the telecommunication equipment e.g. the rack servers 94.1-94.4 which comprise communication equipment 100 such as power supply, power distribution panel, identification what racks are present at the sites and identification of equipment installed at the sites as well as in which racks; and also see figure 13 for the rack equipment description; and the central computer 22 is automatically determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53}.

{see col. 5, lines 34-46 wherein O'KANE, JR. ET AL discloses retrieving data or telecom component information from the databases such as 26 and 68. The telecom component information (equipment description) such as listing of the particular telecom components such as switches, optical fiber, connectors, power supplies};

c) storing with said computer, aid rack equipment description information and said rack equipment management plan

{see figures 1, abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication



equipment information in the database, performance data for particular telecom equipment may be stored}.

O'KANE, JR. ET AL discloses the claimed above except for the feature "wherein at least a portion of the information/data such as equipment management plan and usage polices are automatically received from a customer database" (part of step a). However, O'KANE, JR. ET AL disclose a computer center is connected to various client database, the client/customer access to various database through the network to determine or verify the actual installations, various activities on the equipment and system, updated and maintained current} {see at least figures 1-2, 6A (site information by client 26), abstract, col. 2, lines 43-54, lines 65-67, col. 3, lines 1-2; col. 5, lines 7-13}.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the system of O'KANE, JR. ET AL to including receiving information from the customer database in order to provide a sufficient telecommunication site management system for tracking and updating the status of the equipments at remote sites by receiving equipment information from the customer through the network.

Furthermore, this appears to be a "data processing" method, therefore, the data or information such as *"equipment management and usage policies, rack equipment performance action and a trigger event, an identification of equipment"* have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been

obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

**As for claims 2-3**, which discloses the retrieving performance level setting from the rack equipment, e.g. wattage setting; this is fairly taught in O'KANE, JR. ET AL, see figures 11-13.

**As for claims 4-5**, which discloses the information or guidelines e.g. power and thermal budget guidelines about the rack equipment management plan, this is fairly taught in O'KANE, JR. ET AL, see at least col. 5, lines 48-59.

**As for claim 6**, which discloses interfacing with a service agreement application for formulating the rack equipment plan, this is fairly taught in O'KANE, JR. ET AL {see figures 3, 6 col. 14-27 e.g. CAD drawing"}

**As for claim 7**, which discloses integrating said rack equipment description information with said rack equipment management plan, this is fairly taught in O'KANE, JR. ET AL, figures 1, 5, 6A and 7.

### ***Claim Rejections - 35 USC § 102***

**11.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 8-16, 17- 20 are rejected under 35 U.S.C. 102(b) as being anticipated by O' KANE, JR. ET AL (US 6,366,919)

**As for independent claim 8**, O'KANE, JR. ET AL disclose a rack equipment information coordination system comprising:

a) an equipment description information repository,

{see figure 1, database 26, 302 "*communication equipment is stored*"

b) a management plan information repository for tracking rack equipment management plan, and this repository comprising a physical storage coupled with a computer,

{see figure 1, computer 22, and at least databases 30 and 32},

Furthermore, it appears that these limitations such as "wherein said rack equipment management plan information is used for managing rack equipment while said rack equipment is in operation and is configured for directing a change in operating characteristic of said rack equipment" in step b are also taught in O' KANE, JR. ET AL {see col. 7, lines 13-27, figures 6A " rack configuration, maintain and update" O'KANE, JR. ET AL disclose the management system for maintaining and updating/changing the rack of telecommunication equipment},

c) a coordination component [for coordinating said equipment description information and said rack equipment management plan information, said coordination component implemented by a processor of said computer which is program with instruction for performing said coordinating]

{see figure 1 col. 2, lines 14-54 discloses a computer center is connected either directly or through network such as internet to various databases. With the data stored in these data bases the installation, maintenance updating of the remote telecommunication sites, a client can access the various data bases through the network; and also see figures 1, 2, 3, 5, 10 and 11, col. 2, lines 33-40, col. 9 lines 1-27 disclose a databases of components representing various telecommunication equipment}

d) a repository management component for controls and retrieve the equipment description information and management plan information;

{see figures 1, abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication equipment information in the database, performance data for particular telecom equipment may be stored and {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53 discloses the central computer 22 is automatically determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 }.

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ.

1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, in an apparatus claim, i.e. the phrase "for tracking equipment description information; and tracking equipment management plan information (step a); for coordinating....for performing said coordinating (step c); that controls automatic retrieval.....population" in claim 8 is considered as intended use limitation for the system/device "repository/database", and thus having no patentable weight.

Furthermore, as for the this appears to be a "data processing" method, therefore, the data or information such as "*wherein said equipment descriptive information comprises an identification of equipment type .....rack of equipment*" (Step b) have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of

**As for claims 9-14** which discloses the information e.g. characteristics of rack equipment support equipment, possible operation settings of rack equipment, operating power levels and heat level, performance level information, guideline information, trigger event and management objective which are stored in the repository/database, this is

taught in O'KANE, JR. ET AL, {see figures 1, 7, 11-12, col. 3, lines 60-67, col. 4, lines 1-10, col. 8-10, col. 9, lines 50-67}.

Furthermore, the "the information/data" have been determined to be non-functional descriptive material (NFDm), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

**As for claim 15**, which deal with the coordination component provides a correlation between policies associated with a particular client and rack equipment implementing the client's application, this is taught in O'KANE, JR. ET AL {see figure 13, col. 3, lines 45-47, col. 8, lines 66-67, col. 9, lines 1-28, disclose the configuration and generating the rack equipment images using the CAD application}

**As for claim 16**, O'KANE, JR. ET AL disclose further comprising:  
a repository management component for managing information flow to and from said equipment description information repository and said management plan information repository;

{see figures 1, col. 3, lines 50-67, col. 4, lines 1-10, and lines 33-39 O'KANE, JR. ET AL disclose the management system databases for managing and maintaining the rack of telecommunication equipment and management information}

a communication link for communicating information to and from said

repository management component {see figures 1, 4, network link 24, col. 3, lines 60-67}.

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Cir. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, in an apparatus claim, i.e. the phrase "for managing and for communicating" in claim 8 is considered as intended use limitation for the system/device "repository/database", and thus having no patentable weight.

**As for claim 17**, O'KANE, JR. ET AL disclose a computer system comprising:

a) means for controlling automatic retrieval of rack equipment related information e.g. rack equipment description information, an identification of equipment type of a rack of equipment;

{see figures 1, 5, 7, 11-13 col. 4, lines 4-9; col. 7, lines 64-67; col. 8, lines 1-35 wherein O'KANE, JR. ET AL discloses automatically *monitored* the telecommunication equipment e.g. the rack servers 94.1-94.4 which comprise communication equipment

100 such as power supply, power distribution panel, identification what racks are present at the sites and identification of equipment installed at the sites as well as in which racks; and also see figure 13 for the rack equipment description; and the central computer 22 is *automatically determining and monitoring* the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53}.

{see col. 5, lines 34-46 wherein O'KANE, JR. ET AL discloses retrieving data or telecom component information from the databases such as 26 and 68. The telecom component information (equipment description) such as listing of the particular telecom components such as switches, optical fiber, connectors, power supplies};

b) a means for communicating rack equipment related information [for managing rack equipment while said rack equipment is in operation],

{see figures 1, 2, 5, 10 and 11, col. 3, lines 50-67, and lines 55-60 and col. 8, lines 1-10, O'KANE, JR. ET AL disclose a communication device in the *computer 22* to *communicate with various databases* which stored the information related to the rack telecommunication equipment and for monitoring, determining the rack to be installed from the telecommunication cites, e.g. *equipment power requirement, performance capabilities, data relevant to racks such as sizes, and shape*}.

c) a means for storing said rack equipment related information and instructions [for implementing rack equipment information coordination]



{see figures 1, 2, 3, 5, 10 and 11, col. 3, lines 50-67, col. disclose a communication device in the *computer 22 to communicate with various databases* which stored the information related to the rack equipment, e.g. *equipment power requirement, performance capabilities, data relevant to racks such as sizes, and shape*}.

d) a means for processing information and instructions, wherein said means [for processing information and instructions is configured for processing said instructions and for managing operating characteristics of said rack equipment, and is configured for processing information for managing said rack equipment information coordination]

{see col. 1, lines 16-23, col. 39-46, col. 2, lines 33-37, and col. 2, lines 55-60; at least figures 1, 5, 6A, 10 and 11, disclose the system for managing telecommunication sites/equipment and the rack of telecommunication equipment which enable remote maintenance and reconfiguration of existing equipment

Note: that the [...] is used to indicate intended use which has no patentable weight.

Furthermore, as for the this appears to be a "data processing" method, therefore, the data or information such as "*wherein said equipment descriptive information comprises an identification of equipment type .....rack of equipment*" have been determined to be non-functional descriptive material (NFD), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive

material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

**As for claim 18**, O'KANE, JR. ET AL disclose further comprising:

a) a rack equipment description retrieval module for controlling automatic retrieval of rack equipment description information {see figure 1, at least database 32, which stores telecommunication equipment in racks and data relevant to the racks}

b) a rack equipment management plan module for directing establishment of a rack equipment management plan {see figure 1, 6A, 11, and 13; col. 5, lines 35-59 "design and modify and develop telecommunication site};

c) a rack equipment correlation module for providing correlation instructions to a correlation component {see figures 1, 2, 6A, 10-11}

d) an instruction saving module for directing rack equipment description information and the rack equipment management plan information saving operations {see figure 1}

Note: the system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used,

does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, in an apparatus claim, i.e. the phrase "for controlling...; for directing....; for providing...." in claim 18 is considered as intended use limitation for the system/device "module", and thus having no patentable weight.

**As for claim 19**, which discloses the rack equipment management plan module facilitates determination of rack equipment management objectives, this is taught in O'KANE, JR. ET AL {see figures 6A, and 13}

**As for claim 20**, which discloses the rack equipment management information coordination, is utilized to support a variety of rack equipment management objectives, this is taught in O'KANE, JR. ET AL {see figures 1, 6A and 13}.

**13. Claims 8-16, 17-20** are rejected (2<sup>nd</sup> time) under 35 U.S.C. 103(a) as being unpatentable over O'KANE, JR. ET AL. (US 6,366,919) in view of Applicant Admitted Prior Art (**AAPA**) {pars. 004-0007} or vice versa.

As for independent claim 8, the teaching of O' KANE, JR. ET AL is cited above. AAPA is cited to show an equipment management information system wherein the equipment is about rack equipment. It would have been obvious to modify the system of O' KANE, JR. ET AL by using other equipment type such as rack equipment as taught by AAPA as mere applying the same information management to other similar equipment.

Alternatively, the teachings of AAPA is cited above. It would have been obvious to modify the manual equipment management information system of AAPA by using the

computer automatic equipment management information system of O' KANE, JR. ET AL for the benefits of "*managing ....which enable remote maintenance and reconfiguring of existing equipment ....desired is a system which tracks and updates the content, arrangement, configuration, ...maintenance.*" {see col. 1, lines 39-45}.

As for dep. claims 9-16, they are rejected for the same reasons set forth above to avoid duplicate rejections.

As for independent claim 17, which has similar scope to independent system claim 8 above, it's rejected for the same reason set forth in the rejection of claim 8 above.

As for dep. claims 18-20, they are rejected for the same reasons set forth above to avoid duplicate rejections.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection based on the amended claim.

1) As for a rejection on 101 claims 8-16, the system claims appear to be an apparatus claim in a preamble "*a rack equipment information system*", however, there are no normal structures or functional elements which are required in an apparatus claim. For instant, the independent 8 recited "*an equipment description information repository, a management plan information repository, a coordination component; a repository management component*" are appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

2) On page 9 of the remark, Applicant states that "O'KANE does not teach or suggest either expressly or inherently "a repository management component that controls automatic retrieval of said equipment description information and said management plan information and also controls population of said equipment description information into said equipment description information and population of said management plan information into said management plan information repository" as recited in the amended claim 8 is noted. However, this is not persuasive. OKANE discloses a repository management component as cited in the claim 8 step d {see figures 1, abstract; col. 2, lines 14-54; col. 4, lines 4-17; col. 7, lines 64-67; col. 8, lines 1-35 discloses the databases for storing the rack of telecommunication equipment information in the database, performance data for particular telecom equipment may be stored and {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53 discloses the central computer 22 is automatically determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 }.

Furthermore, it is noted that claim 8 appear to be a system claim. The system claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner

of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Therefore, in an apparatus claim, i.e. the phrase "for tracking equipment description information; and tracking equipment management plan information (step a); for coordinating....for performing said coordinating (step c); that controls automatic retrieval.....population" (step d) in claim 8 is considered as intended use limitation for the system/device "repository/database", and thus having no patentable weight.

3) On page 11 of the remark, O'KANE does not teach or suggest the amended claim 17 "a means for controlling automatic retrieval of rack equipment related information from at least one component.....wherein said rack equipment related information comprises rack equipment description information regarding at least said at least one component and includes an identification of equipment type of said at least one component" is noted. However, this is not persuasive. O'KANE discloses means for controlling automatic retrieval of rack equipment related information e.g. rack equipment description information, an identification of equipment type of a rack of equipment {see figures 1, 5, 7, 11-13 col. 4, lines 4-9; col. 7, lines 64-67; col. 8, lines 1-35 wherein O'KANE, JR. ET AL discloses automatically *monitored* the telecommunication equipment e.g. the rack servers 94.1-94.4 which comprise communication equipment 100 such as power supply, power distribution panel, identification what racks are present at the sites and identification of equipment installed

at the sites as well as in which racks; and also see figure 13 for the rack equipment description; and the central computer 22 is automatically determining and monitoring the equipment 100 in the racks 94 exceeds the maximum allowable power load on the power supplies and back up batteries 106 {see col. 1, lines 25-46; figures 1 and 5; col. 6, lines 15-30, lines 40-53}.

Furthermore, the claim element "means for receiving ....., means for creating ...; means for determining...." is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function and if the "means for" is simply software, and then the system of claim 17 would be software per se and would not be non-statutory.

In additionally, as for the new amended claim language in step a "wherein said rack equipment related information comprise rack equipment description information regarding.....of rack of a equipment" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/T. N./



Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
7/5/09